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DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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MAY 31 2002

Paper No. 11

In re Application of :  
John R. Fredlund *et al* : DECISION ON  
Application No. 09/213,169 : RENEWED PETITION  
Filed: December 17, 1998 :  
Attorney Docket No. 78685F-P :

This is a decision on the renewed petition under 37 CFR 1.181 for withdrawal of the examiner's holding that this application stands abandoned. No fee is required.

The renewed petition is dismissed.

This application currently stands abandoned due to the dismissal of petitioners' appeal for failure to file an appeal brief, 37 CFR 1.192, in an application which contains no allowed claims. A Notice of Abandonment was mailed to petitioners on June 5, 2001. The original petition requesting withdrawal of the holding of abandonment were filed on April 4, 2002, eleven months after petitioners were notified of the abandoned status of the application. The original petition was dismissed pursuant to 37 CFR 1.181(f) and MPEP § 711.03(c), as having been filed more than two (2) months subsequent to notification that the application stands abandoned will be dismissed as untimely absent an appropriate terminal disclaimer. See the Decision on Petition dated April 10, 2002.

Petitioners have now filed a renewed petition accompanied by a terminal disclaimer. However, the terminal disclaimer is not acceptable.

In the Decision on Petition dated April 10, 2002, petitioners were advised of the necessary language which must accompany an untimely petition to withdraw a holding of abandonment. Specifically, petitioners were advised that, as set forth in MPEP § 711.03(c):

"The Office may treat an untimely petition to withdraw the holding of abandonment on its merits in a utility or plant application filed on or after June 8, 1995, on the condition that the petition is accompanied by a terminal disclaimer dedicating to the public a **terminal part of the term of any patent granted thereon that would extend beyond the date 20 years from the filing date of the application, or the earliest application to which the application specifically refers under 35 USC §§ 120, 121, or 365(c).** ... the terminal disclaimer must also apply to any patent granted on any application that claims the benefit of the filing date of the application under 35 USC §§ 120, 121, or 365(c). Such a terminal disclaimer is not required under 37 CFR 1.137(c) because abandonment of an application is a per se failure to exercise due diligence, and as such, an applicant cannot obtain patent term extension under 35 USC § 154(b) due to prosecution delay caused by abandonment of the application. Where a petition to withdraw the holding of abandonment is granted, the application is considered to never have been abandoned and, as such, the prosecution delay caused by the treatment of the application as abandoned is not considered a per se failure to exercise due diligence. Thus a terminal disclaimer is required to avoid granting patent term extension under 35 USC § 154(b) due to prosecution delay caused by the treatment of the application as abandoned." (Emphasis supplied.)


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The terminal disclaimer submitted with the renewed petition contains language tracking the language emphasized above. However, the terminal disclaimer states that language as an alternative to "the period of abandonment of the application", whichever is lesser. The alternative statement is unacceptable, because the period of abandonment of the application is not material to the question of timeliness 37 CFR 1.181(f) as it relates to patent term extension under 35 USC § 154. See the last two sentences in the material quoted above. In other words, there is no option to disclaim the period of abandonment of the application; petitioners must disclaim the period of time as set forth in the emphasized language.

A second renewed petition to withdraw the holding of abandonment may be filed, provided that the renewed petition is filed within two months from the date of this decision. See 37 CFR 1.181(f). The second renewed petition may consist of an appropriate terminal disclaimer and a request that the papers submitted on April 4, 2002 be reconsidered in light of the terminal disclaimer as a timely petition to withdraw the holding of abandonment. The terminal disclaimer must be accompanied by the appropriate disclaimer fee, as the terminal disclaimer submitted with the renewed petition has not been processed and the recording fee has not been charged.

The application is being retained in Technology Center 3700 awaiting the filing of a second renewed petition, or other action deemed appropriate by petitioners.

RENEWED PETITION DISMISSED.

  
E. Rollins-Cross, Director, Patent  
Examining Groups 3710 and 3720

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